

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW W. WILKEY

Appeal No. 1999-0114
Application 08/656,286

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, STAAB,
and GONZALES, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 11-20, all the claims in the application. In the reply brief (Paper No. 20), pages 1-2, appellant "hereby amends the above-identified patent application by

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consenting to the cancellation of Claims 16-20. The Appeal is, therefore, to be considered as being limited to a review of the Examiner's final rejection of Claims 11-15." Such withdrawal operates as a cancellation of claims 16-20 (see Manual of Patent Examining Procedure (MPEP) § 1215.03), leaving claims 11-15 before us for our consideration.

Appellant's invention pertains to a method of packaging two products together side-by-side by wrapping a wrapper of plastic sheet material about the products. Appellant explains on page 1 of the specification that it is known to package products together side-by-side by slipping a preformed sleeve of heat shrink material over the products and then applying heat to the assembled products to shrink the sleeve so that the products become firmly embraced by the sleeve. According to appellant, consumers often have a difficult time removing the sleeve in order to separate the products for use. Appellant's solution to this alleged problem is to provide a wrapper of plastic sheet material having contact adhesive applied to one or more surface areas of the sheet, then wrapping the wrapper about the products so that opposite edges of the wrapper either overlap and bond together via the

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applied contact adhesive, or bond to one of the products. Optionally, the wrapper is made of a heat shrinkage material, such that subsequent to bonding, heat may be applied to shrink the wrapper. According to appellant, since a wrapper made in accordance with the claimed method is held in position by contact adhesive, it may be easily removed by the consumer by simply peeling apart the areas which are held together by the contact adhesive.

Independent claim 11, the sole independent claim on appeal, is illustrative of the appealed subject matter. A copy thereof appears in an appendix to appellant's main brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Weiss	2,885,839	May 12, 1959
Plante	4,244,471	Jan. 13, 1981
Åkerström et al. (Akerstrom)	4,627,218	Dec. 9, 1986
Cosmo	4,984,413	Jan. 15, 1991

The following rejections under 35 U.S.C. § 103 are before us for review:

(a) claims 11, 12 and 14, unpatentable over Weiss in view of Cosmo;

(b) claim 13, unpatentable over Weiss in view of Cosmo,

and further in view of Plante; and

(c) claim 15, unpatentable over Weiss in view of Cosmo,
and further in view of Akerstrom.

Weiss, the examiner's primary reference, pertains to an apparatus for combining together several individual items, for example, milk cartons, into a unitary package 2, wherein the individual items are secured together by an encircling band 10. In rejecting independent claim 11 as being unpatentable over Weiss in view of Cosmo, the examiner considers that the manner in which the apparatus of Weiss applies the bands to the individual items corresponds to the claimed method, except that Weiss does not provide contact adhesive to bond the edges of the wrapper.¹ According to the examiner, it would have been obvious to one of ordinary skill in the art in view of Cosmo to substitute contact adhesive for the adhesive 14, 15 of Weiss "to provide a more secure and removable package" (answer, page 3). Implicit in the rejection is the examiner's position that the modified Weiss method would correspond to

¹The examiner also considers that Weiss does not disclose heat shrinking the wrapper about the products, or cutting the wrapper from a roll; however, independent claim 11 does not require either of these steps.

the method of claim 11 in all respects.

Looking at the disclosure of Weiss in greater detail, we learn that the band 10 used to encircle the individual items is provided at opposite sides of its opposite end portions with coatings of adhesive 14, 15. This adhesive is applied prior to the use of the band ribbon and forms a part of the fabrication of the ribbon itself (column 2, lines 42-50).

Weiss describes the adhesive and its application to the individual items to form a unitary package as follows:

The adhesive utilized is of a *pressure sensitive character* and may be a rubber latex adhesive. During the prefabrication it is allowed to become partially set and to form a substantially dry film which renders these adhesive coatings to be non-adherent towards paper or metallic surfaces in order that the stacks of bands may be shipped or otherwise handled without the hazard of blocking with each other. This type of substantially dry adhesive, which will for all practical purposes adhere only to itself, may be referred to as a dry self-sealing adhesive.

. . . *[W]hen the end portions of the band 10 are overlapped and the adhesive coatings 14 and 15 are brought into overlapping pressure contact these films bond with each other. The union so produced is immediate and highly effective and capable of resisting a longitudinal pull in proportion to the area so joined. In comparison the bond provided by a wet adhesive is slippery and not capable of resisting longitudinal pull. [Column 2, lines 52-72; emphasis added.]*

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When the individual items packaged together comprise containers such as milk cartons, Weiss indicates that the closures 6 of the individual cartons should be located diagonally opposite each other so that "either of the two containers may be emptied without interfering with the other container and *without the need for breaking the band 10*" (column 3, lines 45-47; emphasis added). Weiss goes on to states that the package produced by the disclosed method and apparatus "is such that the

individual containers 1 *are so firmly united with each other that they in effect constitute a single unit*" (column 12, lines 38-40; emphasis added).

From our perspective, Weiss's pressure sensitive adhesive coatings 14 and 15 (column 2, lines 52-54) that firmly bond with each other when brought into overlapping pressure contact (column 2, lines 66-68) constitute a "contact" adhesive. Accordingly, we do not agree with the examiner's position to the extent that it rests on the proposition that claim 11 distinguishes over Weiss on the basis that the adhesive used in the claimed method is a "contact" adhesive. However, claim

11 further requires that the bond produced by the adhesive is such that "the bonded end edge, or edges, of said wrapper is able to be peeled off for separating said products." As read in light of appellant's specification (see, for example, page 1, lines 30-33, and page 4, lines 6-10), we understand this claim terminology as requiring that the bond produced by the adhesive is such that it fails before the material of the wrapper tears when an attempt is made to remove the wrapper by lifting a bonded end edge of the wrapper. In that the pressure sensitive adhesive coatings 14, 15 of Weiss produce an immediate and highly effective bond when overlapped in pressure sensitive contact (column 2, lines 65-68), and firmly unite the individual items with each other so that they in effect constitute a single unit (column 12, lines 39-41), and secure the individual items together so that, in effect, they can only be separated by breaking the band (column 3, lines 45-47), it is, at best, speculative to consider the adhesive of Weiss as being capable of producing a bond of the type called in claim 11 (i.e., so that the bonded end edges of the band 10 are able of being peeled off for separating the individual items). Accordingly, we hold that claim 11

distinguishes over Weiss on the basis of the capability of the adhesive to produce a bond having the characteristics called for in the last three lines of the claim.

Cosmo, the examiner's secondary reference in the rejection of claim 11, is directed to a machine for wrapping a sheet of wrapping material about a generally cylindrical article. To this end, a first end of a web of sheet material 6 is adhered to cylindrical article 1 at station 17 as the cylindrical article rolls down an inclined infeed table 3. Thereafter, a predetermined length of the wrapping material is cut from the web so that as the article continues to roll down the infeed table, the wrapping material wraps itself about the article. The wrapped article is then fed by a conveyor 31 through a heat tunnel 70 where the wrapping material is heat-shrunk into tight engagement with the article. Cosmo discloses (column 4, line 54 through column 5, line 18) various systems for adhering the wrapping material to the article at station 17, including a water atomizing system (Figure 4), a contact adhesive applying system (Figure 5), and a electrostatic generator system (Figure 6).

Because of the need in Cosmo for only a light and

temporary adhesion of the leading edge of the web to the article at station 17, one of ordinary skill in the art would consider Cosmo's adhering systems, including the contact adhesive applying system of Figure 5, as being, at best, unsuitable of producing the sort of strong and robust bond called for in Weiss at, for example, column 2, lines 68-70. This would present a clear *disincentive* to one of ordinary skill in the art to modifying Weiss's pressure sensitive adhesive based on the teachings of Cosmo to arrive at an adhesive having characteristics like those called for in the last three lines of claim 11. Under such circumstances, where the proposed modification would have rendered the primary reference unsuitable for its intended purpose, it cannot be said that the claimed subject matter would have been obvious in light of the teachings of the applied references. *Ex parte Rosenfeld*,

130 USPQ 113, 115 (Bd. App. 1961). Accordingly, the examiner's rejection of claim 11, as well as claims 12 and 14 that depend therefrom, cannot be sustained.

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As to the rejection of claim 13 as being unpatentable further in view of Plante, and the rejection of claim 15 as being unpatentable further in view of Akerstrom, we have carefully reviewed the Plante and Akerstrom references additionally relied upon by the examiner but find nothing therein that makes up for the deficiencies of Weiss and Cosmo discussed *supra*. Therefore, the examiner's rejections of claims 13 and 15 also cannot be sustained.

The decision of the examiner is reversed.

REVERSED

	Harrison E. McCandlish, Senior)	
	Administrative Patent Judge)	
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)	
)	
	Lawrence J. Staab)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	John F. Gonzales)	
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LJS:tdl

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